

REMARKS/ARGUMENTS

In response to the Office Action of May 16, 2005, reconsideration of the application is respectfully requested.

Claims 1-35 have been provisionally rejected for double patenting over claims 1-30 of co-pending application No. 10/124,291. The present application and the co-pending application are owned by the same person. Also, both were filed after November 29, 1999. These facts are clear from the file history and Patent Office records of both applications. Referring to MPEP 706.02(k) it is stated that the rejection can be overcome by:

“...showing that the prior art and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”

Applicant represents that these facts are still true. It is therefore requested that this rejection be withdrawn.

Claims 1, 11-13, 26-30 and 32-35 have been rejected under 35 U.S.C. 102(e) as being anticipated by Melkent et al. (US 6,796,988 B2). In order to reject the claims under 35 U.S.C. 102, each claim must be fully anticipated by the reference. As stated in MPEP 706.02, Section IV:

“the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.”

Referring first to claim 1, the method claim recites:

“mounting the reference device to bone at a location remote from the patient’s spinal column and in a substantially fixed position relative thereto.”

The Office Action states that Melkent anticipates all claimed features in claim 1. Melkent does not disclose this step. In Melkent, the reference array is always attached to the spinal column. At column 3, lines 41 through 43, it is stated:

“The method comprises the steps of: attaching a reference array to the vertebrae of interest. . .”

At column 5, lines 42 through 44, it is stated:

“A reference arc 120. . .is mounted to the spinous process by a clamp or other connecting device. . .”.

At column 8, lines 34 through 38, it is stated:

“A reference array 120 is rigidly attached to the vertebrae of interest. . .The reference array can be attached to a spinous process, for example, in a posterior case or to the anterior body in an anterior case.”

For the above reasons, claim 1 and dependent claims 11-13, 17 and 18 are believed allowable over Melkent and reconsideration of the 102 rejection of these claims is therefore respectfully requested.

Independent claim 19 includes the same limitation as claim 1, that is:

“mounting the reference device to bone at a location remote from the patient’s spinal column and in a substantially fixed position relative thereto”.

Therefore, claim 19 and claims 26-29 that depend from claim 19 are also believed allowable over Melkent for the same reasons as claim 1 and reconsideration of the rejection of these claims is respectfully requested.

Claim 30 and claims 32-35 that depend from claim 30 recite the following:

“. . .providing a surgical navigation reference device, a bone anchor, and a spinal implant;
anchoring the bone anchor to an anterior portion of the iliac region of the patient’s pelvic bone;

coupling the reference device to the bone anchor to mount the reference device in a substantially fixed position relative to the spinal column;. . .” (Emphasis added).

Melkent does not disclose these steps. Therefore, claims 30 and 32-35 are believed allowable over Melkent and reconsideration of the 102 rejection of these claims is respectfully requested.

Claims 11-13, 17, 18, 26-29 and 32-35 have been specifically mentioned on page 2 of the Office Action with regard to the Melkent disclosure. However, the rejection of these claims on the basis of 35 U.S.C. §102 is believed improper because the reference does not teach every aspect of the claimed invention as required in MPEP 706.02, Section IV.

Claims 2-6, 20-23 and 31 have been rejected under 35 U.S.C. 103(a) as unpatentable over Melkent et al. (U.S. 6,796,988 B2). Claims 2-6 depend from claim 1 and therefore include the limitations of claim 1 including the limitation:

“mounting the reference device to bone at a location remote from the patient’s spinal column and in a substantially fixed position relative thereto”.

As regards claims 20-23 and 31, all of these claims include the same limitation. The Office Action has not made a prima facie case of obviousness as a basis for the rejection. There is no motivation disclosed in Melkent nor any suggestion in Melkent as to why the reference device should be mounted remotely from the patient’s spinal column. As indicated in MPEP 2141 in describing the Examiner’s process for making an obviousness rejection “Knowledge of the applicant’s disclosure must be put aside in reaching this determination.” It is submitted therefore that a prima facie case of obviousness has not

been established and therefore the allowance of claims 2-6, 20-23 and 31 is respectfully requested.

Claims 7-10, 14-16, 24 and 25 have been rejected under 35 U.S.C. §103(a) as unpatentable over Melkent et al. (U.S. 6,796,988 B2) in view of Justis et al. (U.S. 6,530,929 B1). Considering first claims 7-10 and 14-16, all of these claims depend from claim 1. Claim 1 recites:

“A method for performing image-guided spinal surgery. . .”

and further recites:

“mounting the reference device to bone at a location remote from the patient's spinal column and in a substantially fixed position relative thereto”.

Neither Melkent nor Justis disclose the claimed subject matter. In order to establish a prima facie case of obviousness Section 2141 of the MPEP provides:

“ . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations”.


None of these requirements is met by the combination of the Melkent et al. and Justis et al. references. There is no teaching in either of these references of how or why they are to be combined to produce the claimed subject matter. A prima facie case of obviousness has not been established. Consequently, reconsideration and allowance of claims 7-10, 14-16, 24 and 25 is respectfully requested.

It should be understood that the above remarks are not intended to provide an exhaustive basis for patentability or concede the basis for the rejections in the Office

Action, but are simply provided to overcome the rejections made in the Office Action in the most expedient fashion.

In view of the above amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and an early notice of allowance is earnestly solicited. If after reviewing this amendment the Examiner feels that any issues remain which must be resolved before the application can be passed to issue, the Examiner is invited to contact the Applicant's undersigned representative by telephone to resolve such issues.

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